



19 DEC 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
www.uspto.gov

Michael J. Rafa  
Inhale Therapeutic System  
150 Industrial Road  
San Carlos, CA 94070

In re Application of YORK et al. :  
Application No.: 10/070,093 :  
PCT No.: PCT/GB00/03328 : DECISION ON PETITION  
Int. Filing: 31 August 2000 :  
Priority Date: 31 August 1999 :  
Attorney Docket No.: 0113.00 : UNDER 37 CFR 1.47(a)  
For: COFORMULATION METHODS AND :  
THEIR PRODUCTS :

This is a decision on applicant's "Petition under 37 CFR 1.183 Petition for Non-Signing Inventor", which is being treated as a petition under 37 CFR 1.47(a), filed in the United States Patent and Trademark Office (USPTO) on 31 July 2002. Applicant requested a one month extension of time, which is granted.

### **BACKGROUND**

On 31 August 2000, applicant filed international application No. PCT/GB00/03328 which claimed priority of an earlier British application filed 31 August 1999. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 08 March 2001.

On 26 March 2001, a Demand for international preliminary examination, in which the United States was elected, was filed prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 28 February 2002.

On 27 February 2002, applicant filed a transmittal letter (PTO-1390) requesting entry into the national stage in the United States of America under 35 U.S.C. § 371. Filed with the Transmittal Letter was, *inter alia*, the requisite basic national fee.

On 01 May 2002, a Notification of Missing Requirements was mailed to applicants indicating that an oath or declaration executed by the inventors and a surcharge for filing the oath or declaration after the thirty month period was required.

On 31 July 2002, in response to the Notification of Missing Requirements, applicants filed a petition under 37 CFR 1.47(a) in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4). The petition requested the acceptance of the application without the signature of inventor, Dr. Ronald Harland, on the grounds that the nonsigning inventor was unavailable to execute the declaration. The petition included the requisite petition fee and a declaration signed

by the 37 CFR 1.47(a) applicant/inventors, Peter York, Simon A. Wilkins, Richard Anthony Storey and Stephen Ernest Walker, on behalf of Ronald Scott Harland.

### DISCUSSION

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Item (1) is satisfied with the payment of the \$130 petition fee. With regard to item (4), the declaration was executed by the available joint inventors on their behalf and on behalf of the non-signing inventor and satisfies the requirements of 37 CFR 1.47(a).

With regard to item (3), a statement of the last known address of the non-signing inventor has not been submitted. With respect to item (2), applicant requests waiver of the requirement that all inventors execute the declaration and declares that “[n]umerous attempts have been made to reach Dr. Ronald Harland, a co-inventor of the present application, but to no avail.” Copies of the correspondence sent to Dr. Harland and Federal Express tracking information confirming delivery were attached to the petition.

#### Inability to Find or Reach Nonsigning Inventor After Diligent Effort

If petitioner is alleging his inability to find or reach a nonsigning inventor after diligent effort, Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP), Proof of Unavailability or Refusal, states, in pertinent part:

Where inability to find or reach a nonsigning inventor “after diligent effort” is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

....

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included statement of facts. It is important that the statement contain facts as opposed to conclusions.

....

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document

may be redacted to remove material not related to the inventor's reasons for refusal.

Here, Petitioner did not submit a statement of facts under 37 CFR 1.47(a.). Although counsel states that numerous attempts were made to reach Dr. Harland, the only evidence submitted to support a finding that the nonsigning inventor was unavailable was the submission of a Federal Express tracking sheet indicating that shipment number 822077037575 was delivered on 10 June 2002 and signed for by "D. Harland". The correspondence to Dr. Harland, provided with the petition, indicates that a Declaration and Assignment were enclosed in the package, but did not include a copy of the application papers (specification, including claims, drawings, and oath or declaration). This is not sufficient evidence to support a finding that the nonsigning inventor cannot be found.

Furthermore, applicant has not satisfied Item (3) above because a statement of the last known address of non-signing inventor Ronald Harland has not been provided.

Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

For these reasons, petitioner has presented insufficient evidence to conclude that applicant/inventor refused to sign the application.

### **CONCLUSION**

The petition under 37 CFR §1.47(a) is **DISMISSED WITHOUT PREJUDICE**.

Any reconsideration on the merits of the petition under 37 CFR §1.47(a) must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.47(a)." No petition fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT Legal, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



Cynthia M. Kratz  
Attorney Advisor  
PCT Legal Office

CMK:cmk

Telephone: (703) 306-5467